

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

OF: HÖSSEL ET AL.

CONFIRMATION No.: 8957

SERIAL No. 09/771,595

GROUP ART UNIT: 1616

FILED: JANUARY 30, 2001

EXAMINER: MARINA LAMM

FOR:

COSMETIC OR DERMATOLOGICAL SUNSCREEN PREPARATIONS

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Alexandria, Va 22313-1450, on:

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Honorable Commissioner
for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY UNDER 37 C.F.R. §1.111

Sir:

In reply to the Office action of January 13, 2004, it is respectfully requested that the following request for reconsideration be entered and considered for further prosecution of the above-identified application:

REQUEST FOR RECONSIDERATION

Claims 1 to 4 and 9 to 19 as submitted with applicants' request for continued examination dated November 06, 2003, are currently pending in this case.

Claims 1 to 4 and 9 to 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable in light of the disclosure of *Dieing et al.* (EP

893 117 U.S. Serial No. 09/122,097) when taken in view of the teachings of *Tanner et al.* (US 5,827,508) and *George et al.* (US 6,165,449).

More particularly, the Examiner contends that a person of ordinary skill in the art would have been motivated to combine a polymer as defined as component (A) of applicants' claims and a metal oxide UV filter as defined as component (B) of applicants' claims because

- *Dieing et al.* teach hair cosmetic compositions which contain as a hair conditioning agent a polymer corresponding to applicants' component (A), and
- *Tanner et al.* teach skin cosmetic compositions which comprise as a UV filter a combination of a dibenzomethane sunscreen compound and a surface treated zinc oxide.

In this context, the Examiner argues that a person of ordinary skill in the art would have been motivated to incorporate the UV filter combination employed by *Tanner et al.* into the hair cosmetic composition of *Dieing et al.* because

- *Tanner et al.* and *George et al.* teach that sunscreen agents are conventionally incorporated into cosmetic compositions to protect the human skin or hair at least partially from UV radiation, and
- *Tanner et al.* teach that the compositions which contain the combination of the dibenzomethane and the surface treated zinc oxide as a UV filter exhibit unexpected photostability, chemical stability and physical stability and further provide good UVA protection.

With a particular view to the latter, the Examiner points out that a person of ordinary skill could reasonably expect that a hair conditioning composition according to the teaching of *Dieing et al.* which contains the combination of the dibenzomethane and the surface treated zinc oxide of *Tanner et al.* as UV filter would exhibit the improved stability as well as the good UVA protection mentioned by *Tanner et al.*

To the extent that the resulting hair conditioning composition can reasonably be expected to exhibit the improved stability applicants agree with the Examiner. Applicants however disagree that the expectation to obtain a stabilized hair conditioning composition and/or the fact that sunscreen components are conventionally employed in hair care cosmetics are sufficient to motivate a person of ordinary

skill in the art to combine *Tanner et al.*'s UV filter combination with the hair conditioning composition disclosed by *Dieing et al.*

It is deemed questionable at best whether a hair conditioning composition which contains *Tanner et al.*'s UV filter combination comprising zinc oxide will provide for a good UVA protection of the hair. In order to protect the hair from UVA radiation the zinc oxide powder would need to remain on the hair. It can, however, not reasonably be expected that an inorganic oxide such as the zinc oxide powder employed by *Tanner et al.* will remain on the hair. Rather, it would appear to be more than likely that the zinc oxide powder is shed from the hair with the result that the UVA protection which is sought is no longer provided. In addition to the loss of UVA protection due to the detachment of the zinc oxide from the hair, the inorganic oxide which is shed from the hair is likely to soil the clothing of a person using the requisite hair conditioning composition.

Bearing in mind that a person of ordinary skill in the art is well acquainted with a host of organic compounds which act as UVA filters as well as compounds which stabilize cosmetic compositions which can reasonably be expected to reliably provide for the effects sought, the mere fact that inorganic pigments such as the zinc oxide employed in *Tanner et al.*'s UV filter combination are also known is not deemed to be sufficient to motivate a person of ordinary skill to employ such an inorganic pigment in a hair conditioning composition. As explained in MPEP §2143, three basic criteria have to be met in order to establish a *prima facie* case of obviousness:

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings,
- (2) there must be a reasonable expectation of success, and
- (3) the prior art reference or the combined references must teach or suggest all of the claim limitations.

Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and cannot be based on applicants' disclosure¹). Neither the prior art applied by the Examiner nor the knowledge available to

1) *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (CAFC 1991)

one of ordinary skill in the art can reasonably be construed to provide the motivation which is necessary for one of ordinary skill in the art to do what applicants have done. The three basic criteria for establishing a prima facie case of obviousness are, therefore, not met in the present case. In light of the foregoing and the arguments already presented by applicants it is therefore respectfully requested that the rejection of Claims 1 to 4 and 9 to 19 under Section 103(a) be withdrawn. Favorable action is respectfully solicited.

REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a three month extension of time be granted in this case. A check for the \$950.00 fee is attached.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 11.0345. Please credit any excess fees to such deposit account.

Respectfully submitted,

KEIL & WEINKAUF



Herbert B. Keil

Reg. No. 18,967

1350 Connecticut Ave, N.W.
Washington, D.C. 20036
(202) 659-0100

HBK/BAS